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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,884	06/07/2001	Toru Kuwahara	100809-16268 (SCET 18.735	7823
26304 7590 02/27/2007 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER APPLE, KIRSTEN SACHWITZ	
			ART UNIT 3693	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			02/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/876,884

Applicant(s)

KUWAHARA, TORU

Examiner

Kirsten S. Apple

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## Detailed Action

This is a non-final action is in response to RCE filed on 11/28/06.

### ***Claim Rejections - 35 USC § 103***

The Examiner has read and reviewed all of the information provided by the Applicant. The examiner rejects as final claims 1 & 3-14 under 35 USC 103.

The Applicant attention is re-drawn to the following:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel (U.S. Patent 6,594,640) in view of Riordan (U.S. Patent 6,078,891.)

**Re claim 1, 7 & 9-14:** Postrel discloses:

A system and method for operating a reward points accumulation and redemption program comprising:

a first storage means (see Postrel, Figure 5, item 10) adapted to store commodity information that includes at least a commodity name and a selling price of a commodity as an object of transaction.

a second storage means (see Postrel, Figure 5, Item 40) adapted to store information specifying combinations of two or more different commodities and adopted to store specific parameters concerning economic return, which are applied respectively to combinations, related information and specific parameters

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and third storage means (see Postrel, Figure 5, Item 30) adapted to store a general-purpose parameter concerning economic return which is applied to commodities other than combination of commodities.

It is clear that Postrel system would be capable of handling such information. The examiner would like to point that that with respect to the additional citation in the claim the currently claim language of “for” is interpreted as intended use only.

Although Postrel does not have specifically describe judging for “combinations of commodities” Riordan specifically teaches “bundle together the sale of two or more items” (See Riordan, Column 9, line 22) and it is commonly known to one of ordinary skill in the art to have marketing promotions that consist of “bundled offers.”

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add bundled offers as taught in Riordan to Postrel.

It is clear that one would be motivated because this would create unique offer that would attract shoppers.

Claim 1 is similar to claim 7 & 9-14. It would be obvious to one of ordinary skill in the art that these claim have similar limitation. Therefore, claims 7 & 9-14 are rejected based on the information provided regarding claim 1.

**Re claim 3:** Postrel discloses:

A system and method for operating a reward points accumulation and redemption program receiving user information (see Postrel, Fig 5, Item 54 “user redemption profile”) and storing user points (see Postrel, Fig 5, Item 54 “user accounts”).

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Additionally, the examiner would like to point that that with respect to the additional citation in the claim the currently claim language of "for" is interpreted as intended use only.

**Re claim 4:** Postrel discloses:

A system and method for operating a reward points accumulation and redemption program utilizes a "reward server conversion rate" (see Postrel, Fig 5, Item 54).

**Re claim 5:** Postrel discloses:

A system and method for operating a reward points accumulation and redemption program utilizes a "reward server conversion rate" (see Postrel, Fig 5, Item 54).

Although Postrel does not have specifically describe judging for "combinations of commodities" Riordan specifically teaches "bundle together the sale of two or more items" (See Riordan; Column 9, line 22) and it is commonly known to one of ordinary skill in the art to have marketing promotions that consist of "bundled offers."

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add bundled offers as taught in Riordan to Postrel. It is clear that Postrel specifics "rates" more than one used for different situations. One such situation could be the "bundled sale" or "combination of commodities."

It is clear that one would be motivated because this would create unique offer that would attract shoppers.

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**Re claim 6:** Postrel discloses:

A system and method for operating a reward points accumulation and redemption program utilizes a "reward server conversion rate" (see Postrel, Fig 5, Item 54).

**Re claim 8:** Postrel discloses:

An order apparatus for operating a reward points accumulation and redemption program utilizes containing a fourth storage (see Postrel, Figure 5, "user accounts")

It is clear that Postrel system would be capable of handling such information. The examiner would like to point that that with respect to the additional citation in the claim the currently claim language of "for" is interpreted as intended use only.

#### ***Allowable Subject Matter***

Claim 2 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

Applicant's arguments filed 11/28/06 have been fully considered but they are not persuasive.

In particular, and respect to Claim 1 the Applicant argued 1<sup>st</sup>: prior art does not have "specific parameter for each combination concerning economic return.

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The Examiner refutes the argument made by the Applicant and draws the attention to see Postrel, Figure 5, Item 40. Additionally the examiner would like to point out that since this claim only recites "concerning economic return" and make no reference to the point system then any marketing 101 book would read on this as a bundled offer.

### ***Contact Information***

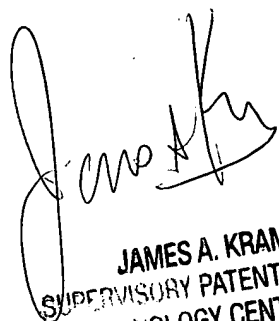
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ksa

 2/20/07  
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